

Serial No.: 09/440,243

Title: METHOD AND APPARATUS FOR MODIFYING AND CONTROLLING PRINT INFORMATION

28. The computer system of claim 27, wherein the override module further comprises machine readable instructions for causing the computer to include sending the plurality of displayed text to a printer.

29. The computer system of claim 27, wherein the override module changes the first color designation for printing of the subset to the second color designation independent of a user input.

30. The computer system of claim 27, wherein the override module changes the first color designation for printing of the subset to the second color designation based on a user identification.

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on June 12, 2001, and the references cited therewith.

Claims 1, 2 and 12 are amended, no claims or added; as a result, claims 1-30 are now pending in this application.

§112 Rejection of the Claims

Claims 1-2 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Office Action asserts that the claims are incomplete. Applicant believes the claims as filed are sufficiently complete and reserves the right to reintroduce the claims in a continuing application. However, in order to expedite prosecution, Applicant has amended the claims to include recitations similar to those suggested in the Office Action. Because the amendments are in substantial accordance with language suggested by the Examiner, it is believed that no new issues are presented with the amendment and that no new search is required. Applicant respectfully requests the withdrawal of the rejection of claims 1 and 2.

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§103 Rejection of the Claims

Claims 1-30 were rejected under 35 USC § 103(a) as being unpatentable over Rivette et al.(US 5,809,318) in view of Narendramath et al. (US 5,751,434). Applicant respectfully traverses the rejection, because there is no *prima facie* case of obviousness with respect to the claims. In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully submits that the claims contain elements not found in the cited art, and that no proper motivation to combine exists.

Independent claim 1 as amended recites "changing the color designation to a printing color designation wherein the color designation remains unchanged for display." The Office Action refers to an "Equivalent File" and states that the file has areas "highlighted by user choice in a color different than the usual default color (black)". The functionality attributed to Rivette does not disclose changing the color designation to a printing color designation while leaving the display color unchanged, it merely indicates that section of the Equivalent file can be highlighted in a designated color. Presumably the highlighted portion would be printed in the highlighted color, because Rivette does not teach or disclose any other way to print the highlighted section. Thus the act of highlighting is designating a color, not overriding or changing a color for printing purposes while keeping the display color unchanged.

In fact, the operation described in Rivette poses the problem that Applicant's invention solves. In Rivette, the Equivalent file will be printed in the same color as that displayed on the monitor. For example, assume that the highlighting color designated by the user is yellow. Further assume that in order to save on color ink expenses, the user only wants the highlighting color to be displayed on a monitor, and does not wish the highlighting color to be printed when printing the highlighted section of the Equivalent File. No mechanism is disclosed in Rivette for

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printing the highlighted section in any other color than that designated by the user. In contrast, Applicant's invention would provide the user in Rivette a way to maintain the highlighting on the display, while changing the designated highlighting color to a printing color.

Furthermore, the Office Action further states that it would have been obvious "that this patent may be printed in default black using printer 57." No support for this proposition is provided in the Office Action, and no secondary reference is cited to support the statement. Per MPEP 2144.03, Applicant respectfully requests that the Examiner provide a secondary reference or an Affidavit supporting the position taken by the Examiner. If the Examiner is referring to the fact that a printer that is incapable of printing in color would print the highlighted portion in black, Applicant respectfully submits that this is not "changing the color designation to a print color designation" because there is no active changing of a color designation to a print designation, the printer merely prints the document in the only color available to it.

Applicant has thoroughly reviewed Narendranath, and can find no reference to overriding and changing a designated color to a printing designation. As a result, neither Rivette nor Narendranath disclose each and every element of Applicants claims, and no *prima facie* case of obviousness exists.

In addition, the Office Action does not provide a proper motivation to combine the references. The Examiner must provide a specific reason to support an obvious rejection. *Ex parte Humphreys*, 24 USPQ2d 1255 (B.P.A.I. 1992). The Office Action only states that a laser printer could print a "PTO Image File" in black and a highlighted "Equivalent File" in multicolor. Thus the Office Action merely states a capability for a laser printer, it does not provide a specific reason why it would have been obvious to combine the references using this capability. Therefore the Office Action has not made a *prima facie* case for obviousness.

Claims 2 and 3 are dependent on claim 1 and provide further patentable distinctions. They are therefore non-obvious for the same reasons as discussed above regarding claim 1. Furthermore, with respect to claim 2, the Office Action states that changing from a non-black color to a black color is a design choice. Applicant respectfully disagrees. The changing of the color provides a functional benefit of saving colored ink, and is therefore more than a design choice.

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For the above reasons, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-30.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6954) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,

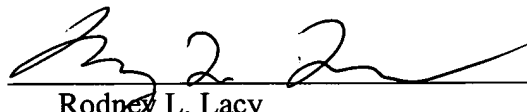
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Date September 12, 2001

By



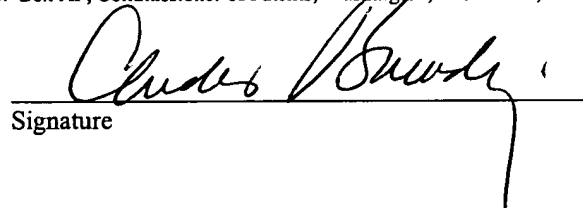
Rodney L. Lacy
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Name

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Signature



Docket No. 00450.264US1
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NO 2000 MAIL ROOM

Clean Version of Pending Claims



**METHOD AND APPARATUS FOR MODIFYING AND CONTROLLING PRINT
INFORMATION**

Applicant: Frank W. Liebenow
Serial No.: 09/440,243

1. A method of printing, comprising:
overriding a color designation for printing of a subset of a plurality of printable information units;
changing the color designation to a printing color designation wherein the color designation remains unchanged for display; and
printing the plurality of printable information units such that the subset is printed in accordance with the printing color designation.
2. The method of claim 1, wherein changing the color designation for printing of the subset of the plurality of printable information units includes changing for printing a non-black color designation of the subset to a black color designation.
3. The method of claim 1, wherein overriding the color designation for printing of the subset of the plurality of printable information units is independent of a user input.
4. A method of printing, comprising:
displaying a plurality of printable information units, wherein a subset in the plurality of printable information units has a first color designation;
changing the first color designation for the subset to a second color designation for printing; and
sending the plurality of printable information units to a printer.
5. The method of claim 4, further comprising printing the plurality of printable information units.

6. The method of claim 4, wherein changing the first color designation for the subset to the second color designation includes changing from a non-black color designation for the subset to a black color designation.
7. The method of claim 4, wherein changing the first color designation for the subset to the second color designation is based on a user input.
8. A method of printing, comprising:
designating a color of a subset of a plurality of displayed text for display;
changing the color of the subset for printing; and
sending the plurality of displayed text to a printer.
9. The method of claim 8, wherein changing the color of the subset for printing includes changing from a non-black color designation of the subset to a black color designation.
10. The method of claim 8, wherein changing the color of the subset for printing is based on a user identification.
11. A method of printing a plurality of printable information units, comprising:
attaching a print code to a subset of the plurality of printable information units, such that the print code precludes printing out the subset; and
sending the plurality of printable information units to a printer.
12. A computer readable medium having instructions stored thereon for causing a computer to perform a method comprising:
overriding a color designation for printing of a subset of a plurality of printable information units;
changing the color designation to a printing color designation wherein the color

designation remains unchanged for display; and

printing the plurality of printable information units such that the subset is printed in accordance with the printing color designation.

13. The computer readable medium of claim 12, wherein overriding the color designation for printing of the subset of the plurality of printable information units includes changing for printing a non-black color designation of the subset to a black color designation.

14. The computer readable medium of claim 12, wherein overriding the color designation for printing of the subset of the plurality of printable information units is independent of a user input.

15. A computer readable medium having instructions stored thereon for causing a computer to perform a method comprising:

displaying a plurality of printable information units, wherein a subset in the plurality of printable information units has a first color designation;

changing the first color designation for the subset to a second color designation for printing; and

sending the plurality of printable information units to a printer.

16. The computer readable medium of claim 15, wherein changing the first color designation for the subset to the second color designation includes changing from a non-black color designation for the subset to a black color designation.

17. A computer readable medium having instructions stored thereon for causing a computer to perform a method comprising:

designating a color for display of a subset of a plurality of displayed text;

changing the color for printing of the subset; and

sending the plurality of displayed text to a printer.

18. The computer readable medium of claim 17, wherein changing the color for printing of the subset includes changing from a non-black color designation of the subset to a black color designation.

19. A system, comprising:

an override module that receives a plurality of printable information units, each one of the plurality of printable information units having a color designation, and overrides the color designation for printing of a subset of the plurality of printable information units; and

a printer, operatively coupled to the override module, that receives the plurality of printable information units and prints the plurality of printable information units.

20. The system of claim 19, wherein the color designation is overridden from a non-black color designation to a black color designation.

21. The system of claim 19, wherein the plurality of printable information units include a plurality of words.

22. The system of claim 19, wherein the override module overrides the color designation independent of a user input.

23. The system of claim 19, wherein the override module overrides the color designation based on a user identification.

24. A system comprising:

a display device that receives a plurality of printable information units and displays the plurality of printable information units, wherein a subset in the plurality of the printable information units has a first color designation;

an override module, operatively coupled to the display device, that receives the plurality of printable information units and changes the first color designation of the subset to a second color designation for printing; and

a printer, operatively coupled to the modification module, that receives the plurality of printable information units and prints the plurality of printable information units.

25. The system of claim 24, wherein the first color designation includes a non-black color and the second color designation includes a black color.

26. The system of claim 24, wherein the override module identifies the subset based on a user input.

27. A computer system comprising:

a computer having a plurality of printable information units, wherein a subset in the plurality of printable information units has a first color designation;

a display device operatively coupled to the computer and capable of displaying the printable information units; and

an override module located in the computer, comprising machine readable instruction for causing the computer to perform a method including changing the first color designation for printing of the subset to a second color designation.

28. The computer system of claim 27, wherein the override module further comprises machine readable instructions for causing the computer to include sending the plurality of displayed text to a printer.

29. The computer system of claim 27, wherein the override module changes the first color designation for printing of the subset to the second color designation independent of a user input.

30. The computer system of claim 27, wherein the override module changes the first color designation for printing of the subset to the second color designation based on a user identification.